

REMARKS**In the Claims**

Claims 1-25 were originally pending.

Claims 2 and 14 were previously canceled without prejudice.

Accordingly, claims 1, 3-13 and 15-25 are pending.

DRAWINGS

Applicant thanks the Examiner for acceptance of replacement figures 5, 11, 14, 22, 24 and 27. Applicant thanks Examiner for rescission of objection to figures 1, 13 and 15 as prior art drawings.

CLAIM INTERPRETATION

The Office Action dated April 5, 2004, took notice on page 2 and equated "illegal synchronization" to unwanted or unauthorized synchronization and workstation to desktop.' Applicant respectfully traverses this official notice and requests a reference that describes such an element. Absent a reference, it appears that personal knowledge is used, so the Applicant respectfully requests an affidavit of the Examiner pertaining to the personal knowledge as required by 37 C.F.R. § 1.104(d)(2).

37 C.F.R. 1.132

Applicant will provide an updated 1.132 affidavit at a later date.

35 U.S.C 103Claims 1, 5, 12, 17, 25 "graphical arc elements"

The Office Action cites Wells page 519, table 1, base topology, as disclosure of "standardized set of graphical arc elements" in claim 1. However, Wells page 519, table 1, base topology, merely shows straight line graphical elements, not arc elements.

The Office Action also cites page 21 lines 19-20 of the specification of the present patent application as authority for the proposition that the arc elements are defined as "real system functional relationships." Applicant offers the clarification that the passage merely indicates that the arc elements are representations of real system functional relationships.

Nonetheless, the Office Action also cites Wells page 510, left column, lines 3-9 and 37-39 as disclosure of arc elements "representing each of a plurality of pre-defined timing." Applicant acknowledges that the simulation process disclosed by Wells is time-based, but Wells does not disclose any graphical elements that represent timing.

The Office Action also cites DOME page 6 as disclosure of graphical arc elements that represent "control and data relationships that can be associated with the pre-defined real system components." Likewise, DOME does not disclose any graphical arc elements that represent control and data relationships.

Obviousness

The Patent Office has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, the Patent Office must show that

1 some objective teaching in the prior art or some knowledge generally available to one of
2 ordinary skill in the art would lead an individual to combine the relevant teaching of the
3 references. *Id.*

4 The *Fine* court stated that:

5 Obviousness is tested by "what the combined teaching of the
6 references would have suggested to those of ordinary skill in the art." *In*
7 *re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it
8 "cannot be established by combining the teachings of the prior art to
9 produce the claimed invention, absent some teaching or suggestion
10 supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221
11 USPQ at 933. And "teachings of references can be combined *only* if there
12 is some suggestion or incentive to do so." *Id.* (emphasis in original).

13 The M.P.E.P. adopts this line of reasoning, stating that

14 In order for the Patent Office to establish a *prima facie* case of
15 obviousness, three base criteria must be met. First, there must be some
16 suggestion or motivation, either in the references themselves or in the
17 knowledge generally available to one of ordinary skill in the art, to modify
18 the reference or to combine reference teachings. Second, there must be a
19 reasonable expectation of success. Finally, the prior art reference (or
20 references when combined) must teach or suggest all the claim limitations.
21 The teaching or suggestion to make the claimed combination and the
22 reasonable expectation of success must both be found in the prior art, and
23 not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*,
24 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

25 An invention can be obvious even though the suggestion to combine prior art
teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir.
1992). At the same time, however, although it is not necessary that the cited references
or prior art specifically suggest making the combination, there must be some teaching
somewhere which provides the suggestion or motivation to combine prior art teachings
and applies that combination to solve the same or similar problem which the claimed
invention addresses. One of ordinary skill in the art will be presumed to know of any
such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502
(Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA
1979)).

Applicant respectfully submits that the Office Action did not make out a *prima*
facie case of obviousness for the following reasons:

1 (1) A suggestion to combine must come from the prior art and not from
2 Applicant's specification or impermissible hindsight.

3 The teaching or suggestion to make the claimed combination and the reasonable
4 expectation of success must both be found in the prior art, not in applicant's disclosure.
5 *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. Hindsight
6 must be avoided hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed.
7 Cir. 1990).

8 (2) The fact that references can be combined or modified is not sufficient.

9 The fact that references can be combined or modified does not render the resultant
10 combination obvious unless the prior art also suggests the desirability of the combination.
11 *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

12 More specifically, the Office Action asserts that "[a]t the time the invention was
13 made it would have been obvious to one of ordinary skill in the art to use DOME to
14 modify Wells et al. since arcing is an inherent graphical representation (DOME; page 65,
15 figure 28). Since its inherent, it must be considered."

16 The Office Action seems to equate inherency with a teaching, suggestion or
17 motivation to combine Wells and DOME. However, inherency is a doctrine of
18 anticipation, inherency is not a doctrine of obviousness. *SmithKline Beecham Corp. v.*
19 *Apotex Corp.*, 03-1285, -1313, 2005 U.S. App. LEXIS 5675, 2005 WL 788426 (Fed. Cir.
20 2005) and *Schering Corp. v. Geneva Pharm'l, Inc.* (CA Nos. 02-1540 to -49 and 03-1021
21 to -27). Therefore, the obviousness rejection of claims 1, 3-13, and 15-25 should be
22 withdrawn.

23 Furthermore, the Office Action does not cite any teaching, suggestion or
24 motivation to combine Wells and DOME. Applicant respectfully submits that this
25 omission is not a trivial matter. Rather, the heart of invention is combining known

1 elements to solve a problem. Combining the elements of Wells and DOME is not shown
2 for any purpose, thus it can not be held that it would have been obvious at the time of the
3 invention to combine Wells and DOME to produce claims 1, 3-13, and 15-25. Applicant
4 respectfully requests withdrawal of the rejection of claims 1, 3-13, and 15-25.

5
6 **Claim Listing under 37 C.F.R. 1.121(c):**

7 Claims 1, 3-13, and 15-25, now pending, are submitted below in accordance with
8 37 C.F.R. 1.121(c).

9
10 Applicant respectfully requests examination and allowance of the subject
11 application. Claims 1, 3-13 and 15-25 are pending.

12 **Request For Notice of Allowance**

13 Applicant requests a Notice of Allowance for pending claims 1, 3-13, and 15-25.

14 Thus, claims 1, 3-13, and 15-25 are allowable. Accordingly, Applicant requests a
15 Notice of Allowance.

Preliminary Amendment
June, 29, 2005
Application 09/728,407

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2 **Conclusion**

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4 Applicant respectfully submits that the claims are in condition for allowance and
5 notification to that effect is earnestly requested. The Examiner is invited to telephone
6 Applicant's attorney (256) 544-6580 to facilitate prosecution of this application.
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9 Respectfully Submitted,

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11 Dated: June 29, 2005

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